UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,119	09/28/2001	Richard Weisbart	13589	4420

7590 01/09/2004

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, NY 11530

EXAMINER	
ROARK, JESSICA H	

ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,119	WEISBART ET AL.	
	Examiner	Art Unit	
	Jessica H. Roark	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *1-7 and 10-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,9 and 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6/24/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. Claims pending: 1-28.

2. Applicant's election with traverse of Group II (claims 8-9, 17-18 and 26-28) with a Species election of Cohn Fraction II+III (claims 8-9 and 28) in the Paper received 10/27/03 is acknowledged. The traversal is on the grounds that the instant invention provides a significant improvement over other products used to practice the claimed method which Applicant asserts means the method may only be practice with the recited product, that separate classification is an insufficient basis for a showing that the inventions are distinct and that costs are excessive. This is not found persuasive for the reasons of record. The requirement is still deemed proper and is therefore made FINAL.

However, it is noted that Applicant has elected product claims. Where Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

3. In view of the art rejections set forth below, claims 1-7 and 10-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 8-9 and 28 *are under consideration in the instant application.*

IDS

4. Applicant's IDS, received 6/24/02, is acknowledged.

Priority

5. Provisional application 60/60/236,255 appears to provide adequate written support for the instant claims.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention *to which the claims are directed.*

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

Claim Rejections – 35 U.S.C. §§ 102 and 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Coval (U.S. Pat No. 4,093,606, see entire document).

Coval teaches the production of gamma globulin suitable for intravenous administration that comprises Fraction II+III (see entire document, e.g., Abstract and Examples).

A composition for intravenous administration is a pharmaceutical composition. Column 3 at lines 54-58. Column 3 at lines 33-41 and 59-63 establishes that the reference to Fraction II+III is to Cohn Fraction II+III.

The reference teachings thus anticipate the instant claimed invention.

10. Claims 8 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Stolle et al. (EP 0 064 210 B2, IDS, see entire document).

Stolle et al teach pharmaceutical compositions for oral administration wherein the composition comprises immune globulin of which at least 70% is IgG (see entire document, but especially pages 3-4 and claim 1). Stolle et al. teach that the immunoglobulin may be Cohn Fraction II+III (see especially page 4 at lines 7-21).

The reference teachings thus anticipate the instant claimed invention.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Coval (U.S. Pat No. 4,093,606) or Stolle et al. (EP 0 064 210 B2, IDS) in view of Miekka et al. (Haemophilia 1998; 4:402-408).

Claim 9, which depends from claim 8, is drawn to a pharmaceutical composition comprising Cohn Fraction II+III *that is irradiated.*

Each of Coval and Stolle et al. teach a pharmaceutical composition comprising Cohn Fraction II+III as set forth in detail supra.

Neither Coval nor Stolle et al. a pharmaceutical composition comprising Cohn Fraction II+III *that is irradiated.*

However, Miekka et al. teach that at the time the invention was made, the art recognized the need to eliminate non-enveloped viruses from biologics including IGIV, and that gamma irradiation was one method of eliminating these pathogens from plasma-derived biologics used as pharmaceuticals (see entire document, e.g., Abstract and introductory statements).

The ordinary artisan at the time the invention was made would therefore have found it obvious to irradiate the pharmaceutical compositions of Cohn Fraction II+III taught by Coval or Stolle et al. The ordinary artisan at the time the invention was made would have been motivated to irradiate the pharmaceutical compositions of either Coval or Stolle et al. comprising Cohn Fraction II+III in order to provide pharmaceutical compositions that did not pose a risk of non-enveloped viral infection to the patient. The ordinary artisan at the time the invention was made would have recognized that the method taught by Miekka et al. could be applied to Cohn Fraction II+III because IGIV is, like Cohn Fraction II+III, a pharmaceutical composition comprising immunoglobulins including IgG.

Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 8 and 9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 8 and 9 of copending Application No. 09/672,911. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

15. No claim is allowed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark, whose telephone number is (703) 605-1209 (effective mid January 2004, this number will change to (571) 272-0848). The examiner can normally be reached Monday from 8:30 to 5:00, and Tuesday/Thursday from 10:00 to 4:00. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached at (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number for before Final submissions is (703) 872-9306.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
January 8, 2004

Phillip Gambel
PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
TECH CENTER 1600
1/8/04